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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/882,363 | 06/15/2001 | Eugene J. Alexander | STAN-144/01US | 6739 |

7590

07/19/2002

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EXAMINER

HINDENBURG, MAX F

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3736

DATE MAILED: 07/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/882,363

Applicant(s)
Alexander et al.

Examiner
Max Hindenburg

Art Unit
3736



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-33 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6 6) ☐ Other:

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1. Claims 10-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 10 is indefinite in that line 3 is apparently missing a word after “includes both” and therefore it is unclear what is being claimed.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, 5, 7, 10, 11, 13, 15, 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Paul et al. Paul et al. teach a method of treating a human with a joint disorder involving cartilage as claimed by applicant including obtaining an electronic MRI image of the joint having both normal and diseased cartilage tissue, electronically evaluating the image to obtain information of volume, thickness and other characteristics, and selecting a therapy based on the information. Therapy of the joint includes administering an agent or drug that stimulates repair of the tissue.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 4, 6, 12, 14 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul et al. in view of DiGioia et al. Paul et al. is discussed above. DiGioia et al. teach a method of therapy for diseased tissue including the step of using osteochondral grafting with desired geometrical features. It would have been obvious to one of ordinary skill in the art, in view of DiGioia et al., to use osteochondral grafting in a desired geometrical shape to best help repair the cartilage tissue.

6. Claims 8, 9, 16-22 and 26-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul et al. in view of Goodman et al. Paul et al. is discussed above. Goodman et al. teach three dimensional mapping of tissue for tissue engineering. It would have been obvious, in view of Goodman et al., to use such a three dimensional mapping method step with Paul et al. to aid in tissue engineering of the replacement tissue or graft. It then would have been obvious to one of ordinary skill in the art to use the method of Paul et al. as modified by Goodman et al. on any body tissue such as bone or bone marrow, to create a physical model for better understanding of the needed replacement, and to measure any desired parameter of the tissue for more complete diagnosis using any desired time and MRI techniques needed for the best results.

7. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

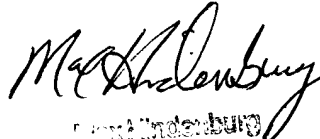
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mr. Hindenburg whose telephone number is (703)308-3130

MH

July 18, 2002


Mark Hindenburg
Primary Examiner